

## **Translating and Understanding Patentability Opinions**

**Patrick G. Burns / Greer, Burns & Crain  
Steven P. Fallon / Greer, Burns & Crain  
Russel J. Barron / Foley & Lardner**

**LES 1998 Annual Meeting  
Miami, Florida**

## OUTLINE

1. Understanding The Level Of Invention Required To Obtain A Patent In the U.S.

Patrick G. Burns

2. Parts Of A Patentability Opinion And Their Separate Functions And Meanings

Steven P. Fallon

3. How Broad Can You Expect The Patent To Be?

Russell J. Barron

# 1. Understanding The Level Of Invention Required To Obtain A Patent In The U.S.

By Patrick G. Burns

## I. Novelty (§ 102)

## II. Nonobviousness (§ 103)

A. Combination of References

B. Suggestion or Motivation to  
Modify and/or Combine

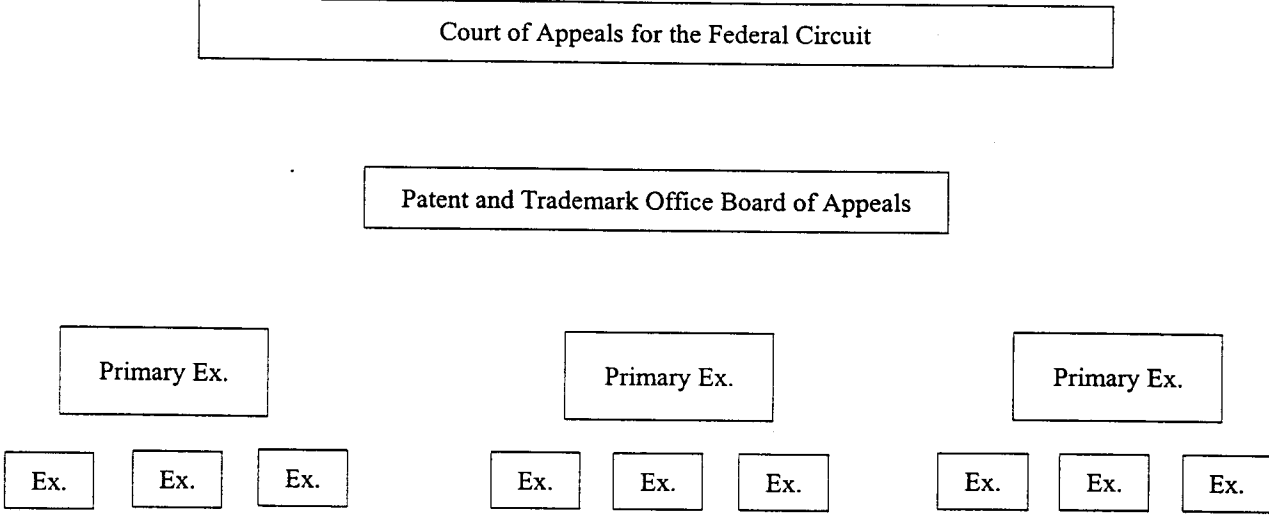
## III. Administration Goals

A. Consistency

B. Predictability

C. Disclosure

# IV. Administrative Structure (Simplified)



## 2. Parts of a Patentability Opinion and Their Separate Functions and Meanings

By Steven P. Fallon

I. Authorization Description

II. Description of Invention

III. Evidence Considered

A. Search

B. Discovered Evidence

C. Search Methodology

D. Client Evidence

#### IV. Analysis of Evidence

#### V. Conclusion of Patentability

A. Legalese Interpretation

B. Identification of Patentable Features

C. Scope of Possible Protection

### 3. How Broad Can You Expect The Patent To Be?

By Russell J. Barron

1. Will the claims of this patent (or patent application) cover the product that we intend to sell?
2. Which ones?
3. How?
4. Have all patentable features of the product been identified?
5. If not, why not? What is needed to do this?
6. What is the nearest prior art?
7. How close to the prior art is the broadest claim?
8. Can the claim be made closer to the prior art?
9. If not, why not?
10. Have the ways of commercially avoiding the broadest claim been considered?

11. If not, why not?
12. Will patent applications be filed on the avoiding techniques?
13. If not, why not?
14. Have alternative technologies been identified?
15. If not, why not?
16. Will patent applications be filed on the alternative technologies?
17. If not, why not?
18. Have the company's rejected technologies been captured?
19. If not, why not?
20. Will patent applications be filed on the rejected technologies?
21. If not, why not?



22. Will patent applications be filed on the:
  - a. product?
  - b. method by which the product works?
  - c. machinery that makes the product?
  - d. method by which the machine works?
  - e. product (if any) produced by the product?
23. If not, why not?
24. Will foreign filing be considered?
25. If not, why not?
26. If so, what countries?
27. Why?
28. What are the short-term and long-term costs for this program?
29. Is it justified against the commercial value contributed by the program?

30. Will the patent describe and picture more than one way ("embodiment") for practicing the invention?
31. If not, why not?
32. Will at least one of the embodiments describe and illustrate the product we are going to sell?
33. If not, why not?
34. Will the claims differ from one another by more than one distinguishing feature?
35. If so, why?
36. Will there be less than 10 claims?
37. If so, why?
38. Will any claims be longer than 16 lines?
39. If so, why?
40. Will there be one set of claims in "means plus function" format?
41. If not, why not?

42. Will every word used in the claims be used in the text of the patent?
43. If not, why not?
44. Will the claims be reviewed to make sure there are no words with special meanings used?
45. If not, why not?
46. If special meanings are used, will they be defined clearly in the text of the patent?
47. If not, why not?
48. If no special meanings are used, will the dictionary be relied on for "ordinary" meanings been selected?
49. If not, why not?
50. Will the selected dictionary definition be referred to in the patent text?
51. If not, why not?
52. Will any of the claims of this patent cover the products of others?

53. If so, which ones?
54. Is this patent licensable?
55. If so, to whom? What royalty stream would result?
56. Can the "invention" be described in one sentence?
57. If not, why not?
58. What is that sentence?